

REMARKS

The Examiner is thanked for the very thorough and professional Office Action and for stating with particularity the reasons for rejection. Pursuant to that Office Action, Claims 1, 3, 4, 6-10, 12, 15 and 17 have been amended to more definitely set forth the invention and obviate the rejection. Further, new Claims 18-20 are presented.

Support in the Specification for the amendment of Claims 1 and 7 can be found on page 5, lines 10-14. Support in the Specification for the amendment of Claims 6 and 17 can be found on page 8, lines 10-16. Support in the Specification for new Claims 18-20 can be found on page 13, lines 7-14, on page 16, line 22, to page 17, line 8, and in Tables 1-2, 2-2, 3-2, and 4-2. These tables show that the evaluation of viscosity-increasing property is A with respect to Examples 1-24, and on page 38, lines 21-26. The present amendment is deemed not to introduce new matter. Claims 1-20 are in the application.

Reconsideration is respectfully requested of the rejection of Claims 1-17 under 35 U.S.C. 103(a) as being unpatentable over Miyazawa, et al. in view of Unger.

The reference of Miyazawa, et al. which is relied upon by the Examiner as a principal reference in the combination rejection under 35 U.S.C. 103(a) has a U.S. filing date of July 26, 2000 and an issue date of May 21, 2002. The Examiner is apparently relying upon the U.S. filing date of Miyazawa, et al. to antedate the filing date of the present application. Thus, the Examiner's combination rejection is in effect a rejection under 35 U.S.C. 103(a)/102(e).

The Examiner's attention is directed to applicants' "Claim For Priority" under 35 U.S.C. 365, filed September 11, 2001, copy attached hereto, which claims priority based upon four prior filed Japanese patent applications, all of which were filed in 2000. Following the submission of

applicants' Claim For Priority under 35 U.S.C. 365, the U.S. PTO issued on December 6, 2001 a 371 Acceptance Letter, confirmation number 4088, copy attached. This Acceptance Letter accorded the present PCT application an international application filing date of January 11, 2001, and a priority date of January 11, 2000 (see the upper right-hand corner of the 371 Acceptance Letter).

In view of the foregoing, it is respectfully submitted that the priority date of the present application of January 11, 2000 is earlier in time than the U.S. filing date of July 26, 2000 for the Miyazawa, et al. reference upon which the Examiner relies. Consequently, it is respectfully submitted that Miyazawa, et al. is not prior art against the present application.

In addition, the present application as well as the Miyazawa, et al. reference are both assigned to Shiseido Company, Ltd., and the reference of Miyazawa, et al. names three inventors which are also listed as co-inventors in the present application. Thus, it is clear from the record that both Miyazawa, et al. and the claimed process herein were, at the time of the inventions, owned by the same person or subject to an obligation of assignment to the same person (Shiseido Company, Ltd.).

The American Inventors Protection Act (AIPA) added subject matter which was prior art under former 35 U.S.C. 103 via 35 U.S.C. 102(e) as disqualified prior art against the claimed invention if that subject matter and the claimed invention "were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person" (see MPEP 706.02(I)(1)).

It is therefore respectfully submitted that the reference of Miyazawa, et al. is disqualified as a reference under 35 U.S.C. 103 under Section(b)(B) since both the present application and

Miyazawa, et al. were at the time the inventions were made owned by the same person or subject to an obligation of assignment to Shiseido Company, Ltd. Consequently, Miyazawa, et al. is not a proper reference under 35 U.S.C. 103(a).

In any event, Miyazawa et al., discloses only a microcapsule. The process for producing the microcapsule is not similar to the process for producing a microgel of the present invention.

Miyazawa, et al. discloses that a hydrophilic polymer gelling agent is dissolved in water to prepare an aqueous gelling agent solution, and the aqueous gelling agent solution is added to an oil-in-water-soluble-solvent type emulsion at a hardening temperature of the gelling agent or higher to prepare an O/W emulsion (the water phase containing the hydrophilic polymer gelling agent).

The O/W emulsion is emulsified into an outer oil phase to prepare an O/W/O emulsion while maintaining the temperature of the O/W/O emulsion at the hardening temperature or higher; and then the O/W/O emulsion is cooled to the hardening temperature or lower to harden the water phase of the O/W/O emulsion, thus making microcapsules. In Miyazawa, et al., the water phase containing the hydrophilic polymer gelling agent is hardened in the form of particles. The obtained particles (microcapsules) are not pulverized anymore.

In contrast, in the present invention, a hydrophilic compound capable of forming a gel is dissolved in an aqueous solvent, the resultant mixture is allowed to stand until the temperature of the mixture becomes lower than the gelation temperature to thereby form a gel, and the gel is pulverized into a microgel. In the present invention, the mixture containing a hydrophilic compound capable of forming a gel is hardened in the form of “a block” (a chunk of a gel is obtained), and then the block is pulverized into a microgel.

As described above, the process for producing the microgel of the present invention is unquestionably different from and not obvious when considered in light of the process for producing a microcapsule in Miyazawa, et al.

Further, the microgel of the present invention has excellent characteristics. The microgel of the present invention is available as a viscosity control agent and can increase the viscosity of an external composition when it is incorporated therein. In particular, even where the external composition contains a pharmaceutical ingredient or salt, the viscosity of the composition is not lowered. That is, when the microgel of the present invention is incorporated, an external composition having excellent resistance to a salt or a pharmaceutical ingredient can be obtained. It is respectfully submitted that Miyazawa, et al. neither describes nor mentions that the microcapsule produced in the reference have such characteristics.

The Examiner's secondary reference of Unger describes that a resultant gel may then be treated to form gel particles (col.5, lines 63-64). However, the Unger reference relates to contrast media for use in X-ray, MRI imaging, etc., and that the contrast media contains metals and is heat stable and stable in long term storage. It is respectfully urged that the technical field of Unger differs from that of Miyazawa, et al. Consequently, a person skilled in the art would have no motivation to combine the disclosure of Miyazawa, et al. with that of Unger since these references are in non-analogous arts.

It is respectfully submitted that there is no disclosure whatever in Unger that when the gel is pulverized into a microgel, the microgel can increase the viscosity of an external composition, and the microgel can provide an external composition having excellent resistance to a salt or a pharmaceutical

ingredient. On the contrary, that teaching or suggestion comes only from the present application and constitutes an important element or aspect of the present invention.

Therefore, claims 1-6 (the process for producing a microgel), claims 7-17 (the process for producing an external composition), and claims 18-20 (the method of increasing viscosity of an external composition) are neither anticipated by nor unpatentably obvious over the Examiner's cited combination of references.

In view of the foregoing, it is respectfully submitted that the application is now in condition for allowance, and early action and allowance thereof is accordingly respectfully requested. If there is any reason why the application cannot be allowed at the present time, it is respectfully requested that the Examiner contact the undersigned at the number listed below to resolve any problems.

Respectfully submitted,

TOWNSEND & BANTA

A handwritten signature in black ink, appearing to read 'Donald E. Townsend', written over a horizontal line.

Donald E. Townsend
Registration No. 22,069

Customer No. 27966

Date: March 23, 2006

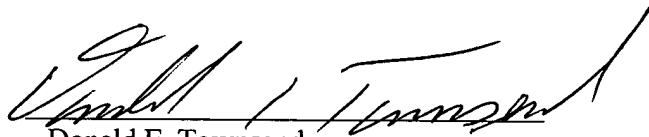
TOWNSEND & BANTA
c/o FoundationIP
P.O. Box 52050
Minneapolis, MN 55402
(202)220-3124



CERTIFICATE OF MAILING

The undersigned hereby certifies that this Amendment and Transmittal in Application Serial No. 09/936,317, is being deposited as first-class mail on the date indicated below with the United States Postal Service pursuant to 37 CFR 1.10, and is addressed to the Commissioner For Patents, P.O.Box 1450, Alexandria, VA 22313-1450.

Date: March 23, 2006


Donald E. Townsend